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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------------|------------------|
| 10/682,650 | 10/09/2003 | Yongfei Zhu | JSF001-0056D1/WJT08-0014D | 8252 |
| 7590 | 06/17/2004 | | EXAMINER | |
| James S. Finn #2825 8650 Southwestern Blvd. Dallas, TX 75206-2688 | | | JONES, STEPHEN E | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2817 | |

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/682,650 | ZHU ET AL. | |
| | Examiner | Art Unit | |
| | Stephen E. Jones | 2817 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 May 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4 and 6-11 is/are pending in the application.
 4a) Of the above claim(s) 4,6-9 and 11 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-3 and 10 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) 1-4 and 6-11 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 10/9/03 (4 pages).
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of species IV (Figs. 19, 20, 5, 6, 9, 10, 13, and 14) in Paper No. 5/3/04 is acknowledged. Applicant indicated that claims 1-4 and 6-11 read on the elected species. However, upon examination it appears that Claim 4 more appropriately reads on a non-elected figure such as Fig. 21 which teaches a second varactor (226) connected to the resonator electrode.

Accordingly, Claims 4, 6-9, and 11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5/3/04.

Specification

1. The disclosure is objected to because of the following informalities:

The continuing data in the first paragraph should be updated (i.e. –now US Patent No. 6,686,817--).

Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agahi-Kesheh (WO94/27376) in view of Dimos et al.

Agahi-Kesheh teaches a ceramic block filter including: input/outputs (466, 472) with resonators (352' and 412') coupled to them; each resonator can have a voltage tunable varactor on the top surface of the block connected between the electrode in the openings of the resonator and ground electrodes on the outside surface (e.g. see page 12, lines 6-17) (Claim 2); and the top surface is partially metallized (Claim 3).

However, Agahi-Kesheh does not teach the specific construction of the voltage tunable varactor or explicitly that the varactor is a tunable dielectric varactor capable of being operated at room temperature (Claim 1) or that the tunable layer is a thin film (Claim 10).

Dimos (Fig. 9) teaches a thin film tunable dielectric varactor and that the device provides unexpected/surprising properties at room temperature (i.e. it is capable of being operated at room temperature)(e.g. see Col. 3, lines 21-36).

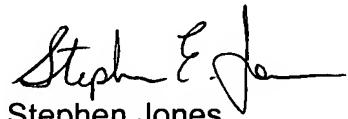
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It would have been considered obvious to one of ordinary skill in the art to have substituted voltage tunable dielectric varactors such as taught by Dimos in place of the generic voltage tunable varactors in the Agahi-Kesheh device, because it would have been a mere selection of a specific well-known voltage tunable varactor means for providing tuning of the filter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen E. Jones whose telephone number is 571-272-1762. The examiner can normally be reached on Monday through Friday from 8 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Pascal can be reached on 571-272-1769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Stephen Jones
Patent Examiner
Art Unit 2817

SEJ